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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,249	04/18/2006	Masahiko Kubota	03500.102481.	8843

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FITZPATRICK CELLA HARPER & SCINTO
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NEW YORK, NY 10112

EXAMINER

MCPHERSON, JOHN A

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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11/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,249	Applicant(s) KUBOTA ET AL.	
	Examiner John A. McPherson	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/22/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the Amendment filed 7/22/08.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 380 423 [cited in the Information Disclosure Statement filed 4/18/06] (EP '423) in view of JP 2001-179990 [cited in the Information Disclosure Statement filed 4/18/06] (JP '990) for the reasons of record as set forth in paragraph 1 of the Office Action mailed 2/22/08, and as further discussed below.

3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 380 425 [cited in the Information Disclosure Statement filed 4/18/06] (EP '425) in view of JP 2001-179990 [cited in the Information Disclosure Statement filed 4/18/06] (JP '990) for the reasons of record as set forth in paragraph 2 of the Office Action mailed 2/22/08, and as further discussed below.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 380 423 [cited in the Information Disclosure Statement filed 4/18/06] (EP '423) in view of JP 2001-179990 [cited in the Information Disclosure Statement filed 4/18/06] (JP '990) as applied to claim 1-6 and 9 above, and further in view of either one of EP 1 013 648 (EP '648) or the abstract of SE 200001340 (the abstract of SE '430).

The disclosure of EP '423 in view of JP '990 is set forth in paragraph 1 of the Office Action mailed 2/22/08. However, neither EP '423 nor JP '990 disclose utilizing triethanolamine as the amine which functions as an inhibitor of cationic polymerization in the covering resin layer.

EP '648 discloses a method for storage stabilization of compounds with oxetane rings, wherein a basic compound, such as triethanolamine, is added as an inhibitor of cationic ring-opening polymerization. See the abstract; and paragraphs [0012] and [0013].

The abstract of SE '340 discloses a stabilized oxetane comprising an oxetane compound mixed with one or more nucleophile inhibitor(s), exemplified by triethanolamine, so as to greatly reduce or completely prevent spontaneous or premature polymerization.

It would have been obvious to one skilled in the requisite art to include triethanolamine, as taught by either one of EP '648 or the abstract of SE '340, as the amine in the method of EP '423 in view of JP '990 because it is taught that triethanolamine is an art-recognized example of an amine which functions as an inhibitor of cationic polymerization.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 380 425 [cited in the Information Disclosure Statement filed 4/18/06] (EP '425) in view of JP 2001-179990 [cited in the Information Disclosure Statement filed 4/18/06] (JP '990) as applied to claims 1-9 above, and further in view of either one of EP 1 013 648 (EP '648) or the abstract of SE 200001340 (abstract of SE '430).

The disclosure of EP '425 in view of JP '990 is set forth in paragraph 2 of the Office Action mailed 2/22/08. However, neither EP '425 nor JP '990 disclose utilizing triethanolamine as the amine which functions as an inhibitor of cationic polymerization in the covering resin layer.

EP '648 discloses a method for storage stabilization of compounds with oxetane rings, wherein a basic compound, such as triethanolamine, is added as an inhibitor of cationic ring-opening polymerization. See the abstract; and paragraphs [0012] and [0013].

The abstract of SE '340 discloses a stabilized oxetane comprising an oxetane compound mixed with one or more nucleophile inhibitor(s), exemplified by triethanolamine, so as to greatly reduce or completely prevent spontaneous or premature polymerization.

It would have been obvious to one skilled in the requisite art to include triethanolamine, as taught by either one of EP '648 or the abstract of SE '340, as the amine in the method of EP '425 in view of JP '990 because it is taught that triethanolamine is an art-recognized example of an amine which functions as an inhibitor of cationic polymerization.

Claim Rejections - 35 USC § 102/103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2001-179990 [cited in the Information Disclosure Statement filed 4/18/06] (JP '990) for the reasons of record as set forth in paragraph 3 of the Office Action mailed 2/22/08, and as further discussed below.

Response to Arguments

7. Applicant's arguments filed 7/22/08 have been fully considered but they are not persuasive.

With respect to the 35 USC 103 rejections over either one of EP '423 or EP '425 in view of JP '990 (Imamura), Applicant argues that in Imamura, while a solid layer or liquid material coated thereon may include a cationic polymerization inhibitor, that layer or liquid material does not undergo the lithographic process and is not a member where a discharge port is formed. However, the solid layer 5 of JP '990, also referred to as the

Art Unit: 1795

photosensitive coating resin layer **5** and the nozzle formation member **5**, which contains the basic substance (see both abstracts; and paragraphs [0034], [0035] and [0075] of the computer-generated translation) is coated on ink pass pattern **4**, exposed through a mask **6** using the conventional photolithographic technique, and developed using a suitable solvent to form an ink delivery **8** (i.e. a discharge port). See paragraphs [0050]-[0054] of the computer-generated translation; and Figures 2-6.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1795

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (571) 272-1386. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John A. McPherson/
Primary Examiner, Art Unit 1795

11/4/08
JAM